

REMARKS

The present response is to the Office Action mailed in the above-referenced case on October 27, 2003. Claims 1, 3, 4, 9, 10, 12-15 and 26-28 are standing for examination. The Examiner has rejected claim 10 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 12 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1, 3-4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rekhter et al. ("Tag Switching Architecture"), hereinafter Rekhter, in view of Davie et al. ("Explicit Route Support in MPLS"), hereinafter Davie, and further in view of Semeria ("Multiprotocol Label Switching: Enhancing Routing in the New Public Network"), hereinafter Semeria. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rekhter in view of Davie, further in view of Semeria as applied to claim 8, and further in view of Woodcock et al. ("Microsoft Press Computer Dictionary"), hereinafter Woodcock.

Regarding independent claims 12 and 26, and the depending claims, the Examiner has provided on page 6, paragraph 7, remarks pertaining to claim 12 being unpatentable over the combined prior art, and on page 8 paragraph 10 apparently pertaining to independent claim 26, although the Examiner refers to claim 20, which applicant believes is stated by the Examiner in error. Although the Examiner has not specifically cited claim rejections for independent claims 12 and 26 on their merits in the Examiner's remarks of the instant Office Action, applicant herein assumes that the independent claims and the depending claims are indeed rejected by the Examiner, based on the Examiner's remarks, and will treat the claims as such in the instant response.

Independent claims 12 and 26 were indicated as allowable by the Examiner in the previous Office Action dated April 1, 2003. However, both claims are rejected by the Examiner in the instant Office Action, and the Examiner has not in the present action explicitly withdrawn the allowability for the claims. Both claims recite the characterization in that a response signal includes a label word which defines a plurality of data bits. The Examiner has stated in the instant Office Action that the reference of Davie discloses this specific limitation. Applicant has carefully and thoroughly reviewed the reference of Davie, and has found no teaching or suggestion whatsoever of the label

word of the response signal defining a plurality of data bits. Davie teaches establishing or defining explicitly routed paths in an MPLS environment, but nowhere teaches the specific limitation of applicant's claims. Further, the Examiner has not provided any specific portion of Davie which explicitly teaches or suggests this specific limitation. The combined art, therefore, fails to teach or suggest all the limitations of applicant's independent claims 12 and 26.

Regarding the Examiner's 112 rejection of claim 10 on page 2, paragraph 2, claim 10 recites that the logical operation is performed on an address field in the packet, and claim 1, from which claim 10 depends, recites performing a logical operation on the protocol field of the packet, and the Examiner has stated that claim 10, as such, recites performing logical operations on both fields, and is therefore not properly enabled by the specification, which teaches that a logical operation can be performed on either the address field or the protocol field, but fails to disclose performing the logical operation on both fields.

In response, applicant respectfully traverses the Examiner's position, and points out that if applicant's specification explains that a logical operation may be performed on either the address field or the protocol field, it only follows that the logical operation may therefore be performed on both fields, and the recitation of claim 10 is therefore indeed enabled. Applicant argues that the Examiner's interpretation of the recitation of claims 1 and 10 pertaining to performing the logical operation on "either or both" fields is incorrect and improper. If the logical operation is enabled to be performed on either field, as taught in applicant's specification, then it is clearly inherent that it may be performed on both. It has not been taught in the specification that the logical operation on one or the other is exclusive.

Further to the above, referring again to claim 10 and the Examiner's 112 rejection of the claim, applicant respectfully points out that in the previous rounds of prosecution the Examiner, in the first Office Action dated October 8, 2002, as well as in the second Office Action dated April 01, 2003, dealt with claim 10 as though it was an enabled claim, but in the instant Office Action the Examiner has changed the position, resulting in the 112 rejection of the claim as non-enabling, even though there were no amendments made by applicant to the claim in the previous Office Action responses, other than a

change in dependency, which was due to applicant's cancellation of claim 8. Applicant points out that, by the fact that the Examiner has previously dealt with claim 10 as enabling through two rounds of prosecution, applicant therefore reserves and asserts the right to assume that the claim is enabled. Applicant fails to understand how the claim can now become non-enabled, even though no amendments to the language of the claim have been previously made by applicant.

Regarding the Examiner's 112 rejection of claims 12 and 26 as being indefinite, the Examiner has objected to the limitation "includes a label word which defines a plurality of bits" stating that the limitation is unclear, adding that normally, in the art, pluralities of bits define label words, not the other way around. Applicant respectfully traverses the Examiner's statement. Applicant argues that a set of bits can certainly be defined by a label word or vice versa. Applicant points out to the Examiner that on page 7 of the instant Office Action, referring to claim 12, the Examiner has stated specifically that the reference of Davie discloses that "the response signal includes a label word which defines a plurality of data bits,...". If the specific limitation of applicant's claims objected to by the Examiner is disclosed in the prior art, as stated by the Examiner, applicant fails to understand how claims 12 and 26 can possibly fail to be clear to the Examiner.

Further to the above, applicant argues that the fact that a plurality of bits in the art usually defines the label word, does not automatically negate applicant's disclosure that the label word of the response signal defines the plurality of data bits. Applicant asserts that the label word of the response signal most certainly can define the plurality of bits, and applicant believes it is the Examiner's interpretation of the term "define" which is unclear and improper. In view of the above, applicant therefore traverses the Examiner's position.

Regarding the Examiner's merit rejections of applicant's claims, the Examiner has rejected claims 1, 3-4 and 10 as unpatentable over Rekhter in view of Davie and further in view of Semeria, and is of the position that the combined art teaches or suggests all of the limitations of applicant's independent and depending claims.

Referring to claim 1, applicant amended the language of claim 1 in the previous Office Action response dated April 01, 2003 to include the limitation of claim 11, which

was indicated by the Examiner as being objected to for depending from a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and intervening claims. In response applicant amended the language of claim 1 to include the patentable limitation of claim 11 and intervening claim 8, therefore making claim 1 a patentable claim.

In the instant Office Action the Examiner has rejected claim 1 as previously amended on the merits, even though the Examiner has not cited and applied any additional reference or portions of prior art references, nor has the Examiner provided any additional arguments to change the previous indication of allowability. In fact, the Examiner in the instant Office Action has cited and applied exactly the same portions of all of the combined references relied upon in the Examiner's rejection of the previous Office Action. Applicant adds further that, in the instant Office Action, the Examiner has not explicitly withdrawn the allowability indicated for claim 11 for the patentable subject matter, which now is specifically recited in claim 1, thereby making claim 1 still a patentable claim. Applicant, therefore assumes that claim 1 remains patentable, lacking any new art or argument provided by the Examiner, and insists that the rejection of the claim be withdrawn and the claim be allowed, or otherwise, that the Examiner provide applicant with the required additional prior art references and supporting argument.

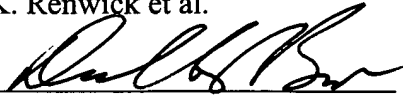
The Examiner has rejected claim 9 as unpatentable over Rekhter in view of Davie, further in view of Semeria as applied to claim 8, and further in view of Woodcock. Applicant respectfully points out to the Examiner that firstly, claim 8 has been canceled by applicant in previous amendment, and secondly, that claim 9 as previously amended now depends from claim 1, which now recites patentable subject matter, as has been indicated by the Examiner in the last Office Action response dated April 1, 2003, thereby making claim 9 patentable on its own merits, or at least as depended from a patentable claim.

As argued above by applicant independent claims 1, 12 and 26 are then patentable over the prior art presented by the Examiner, either singly or in combination. Depending claims 2-4, 9-10, 13-15 and 27-28, are therefore patentable on their own merits, or at least as depended from a patentable claim.

It is therefore respectfully requested that this application be reconsidered, the claims be allowed, and that this case be passed quickly to issue. If there are any time extensions needed beyond any extension specifically requested with this amendment, such extension of time is hereby requested. If there are any fees due beyond any fees paid with this amendment, authorization is given to deduct such fees from deposit account 50-0534.

Respectfully Submitted,
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by



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